

DETAILED ACTION

Applicants' Preliminary Amendment, filed 12/30/05 has been entered. Claims 1-26 are pending.

Claims 23-26 provide for the use of an ES cell preparation but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. These claims are withdrawn from consideration because the Examiner is unable to determine the method or process intended by the claims. If the claims are amended, the Examiner will, at that time, determine the appropriate group(s) for the amended claims, and whether the amended claims fall within the elected group.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-10, 12, 16-22 drawn to preparations of non-inbred mouse ES cells and methods for preparing mouse embryonic stem cells having good developmental potential.

Group II, claim(s) 11, drawn to a method for producing an ES cell-derived gene targeted mouse.

Group III, claim(s) 13-15 drawn to ES cell-derived mice.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Unity of Invention between different categories of inventions will only be found to exist if specific combinations of inventions are present. Those combinations include:

- 1) A product and a special process of manufacture of said product
- 2) A product and a process of use of said product
- 3) A product, a special process of manufacture of said product, and a process of use of said product
- 4) A process and an apparatus specially designed to carry out said process
- 5) A product, a special process of manufacture of said product, and an apparatus specially designed to carry out said process.

The allowed combinations do not include multiple products, multiple methods of using said products, and methods of making multiple products as claimed in the instant invention.

37 CFR 1.475 (c) states that:

"If an application contains claims to more or less than one of the combination of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present."

37 CFR 1.475 (d) states:

"If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and 1.476(c)."

37 CFR 1.475(e) states:

"The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternative within a single claim."

In the instant case, unity of invention is lacking because the corresponding technical feature does not contribute over the prior art. In the instant case, the corresponding technical feature is determined to be non-inbred mouse ES cells. However, these cells are known in the art. For example, US PG Pub No: 2002/0062493 A1 (Eggen *et al.*, May 23, 2002) teach non-inbred pluripotent cells (p. 3, ¶17). Accordingly, the technical feature of the instant claims fails to provide unity of invention.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thaian N. Ton whose telephone number is (571)272-0736. The examiner can normally be reached on 9-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thaian N. Ton/
Primary Examiner, Art Unit 1632